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EXAMINER
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ART UNIT	PAPER NUMBER
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1611

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

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Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments filed on 9/30/11 have been considered but not found persuasive. Applicants argue that the Office does not cite MPEP or CFR to place burden on applicants and instead it is Office's burden to show that the cited references disclose each element claimed. While it is true that the burden of establishing prima facie obviousness rests on the Office, MPEP 2100 states If a prima facie case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. See, e.g., *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990). In this regard, it is the position of the examiner the prior art record teaches the claimed invention as explained in the rejection (dated 8/4/11). Applicants argue that claimed "equilibrium swell of a colloid" is not the same as "obtaining equilibrium swell with predetermined water content" that is taught by Wittwer reference. Applicants' arguments are not persuasive because applicants have not explained or shown how and why the absorption of predetermined water content cannot reach equilibrium swell. On the other hand, instant claim has been rejected under obviousness and it would have been within the purview of a skilled artisan to control the absorption of water by a colloid(in the teachings of Wittwer) so as to obtain the maximum "equilibrium swell", which applicants defined as "percent swell" (see the arguments presented by applicants on 11-25-09). Furthermore, Wittwer does recognize that the swellability of a colloid can be controlled by the *amount of water absorbed, thus teaching water absorption as a result-effective variable*. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Thus, in contrast to applicants' argument, the examiner does not argue that the swell is inherent and instead one skilled in the art would have been able to control the percent swelling of a colloid.

In response to the argument that the reference lacks any rationale for "obvious to try" Wittwer teaches the swelling of colloids to avoid long conditioning times of the colloids at high temperatures and high humidity conditions (col. 1). Applicants argue that Wittwer does not provide any direction and instead vaguely states hydrophilic polymer may be modified with the crosslinking agents. It is argued that it strains the bounds of credulity to suggest that Wittwer guides the artisan toward a particular solution, by providing a finite number of identified and

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predictable solutions, and that the finite number of options is small or easily traversed, as required by the "obvious to try" rationale. Applicants' arguments are not persuasive because Wittwer species the hydrocolloid polymer, gelatin, and further teaches hydration of the polymer and therefore, one skilled in the art would have reasonably related the crosslinking of the polymer to gelatin and the process achieved with the crosslinking agents taught by Wittwer. Thus, employing crosslinking agents to crosslink a polymer such as gelatin or other swellable polymers in a known technique in the prior art (as seen from the teachings of Wittwer) and hence proper to apply the "obvious to try" standard. In response to the argument regarding the degradation time, once again the examiner opines that the reference (Wittwer) teaches the claimed polymer, preparing swollen polymers by water absorption and further crosslinking the polymers. Further, Wittwer teaches gelatin polymer, which is also claimed. The argument that Wittwer teaches that the polymers avoid mechanical and chemical degradation is not persuasive because instant claims do not state chemical or mechanical and instead requires "in vivo" degradation, which can be considered biological. While Wittwer does not recognize the property claimed, "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on '*prima facie* obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

With respect to the applicants' argument that Hubbell is not utilized in the combination, firstly, for claims 1, 19, 21 and 24, the rejection does not employ the teachings of Hubbell. However, for the argued "single phase and substantially free of water phase", Rothman reference has been used, which does not teach including any other substance or component in the polysaccharide suspension other than for the formation of the gel or the ability to form a gel, and also states that the gels contain more than 50% by weight water but less than 98% water (col. 4, L 58-70), which implies that the gels do not contain any free water. Thus, Rothman does teach gels that are free of other substances and also free of any free water. Secondly, Hubbell is cited for claims 30-32 and 35-56, in addition to the teachings of Wittwer, Rothman and Cioca

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references. Thus, for both sets of claims Rothman reference does teach “gels” free of free water and additional substances (single phase). Applicants argue that the dependent claims are allowable because of their dependence on independent claims (that are allowable). However, the independent claims are not allowable, as explained above, and hence the rejections of record have been maintained.